

being allegedly indefinite because Claim 1 merely recites a use without any active, positive steps delimiting how this use is actually practised.

The Examiner rejected Claim 1 under 35 U.S.C. 101 as being allegedly an improper definition of a process because the claim does not set forth steps of the process.

The Examiner rejected Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(b) as being allegedly anticipated by JP Pat. Application No. 1-139515 A.

The Examiner rejected Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(b) as being allegedly anticipated by JP Pat. Application No. 8-239305 A.

The Examiner rejected Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(e) as being allegedly anticipated by U.S. Patent No. 6,244,518 B1.

The Examiner rejected Claims 1-4 and 6-12 under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 5,417,973 ('973) in view of U.S. Pat. No. 4,965,070 ('070).

The Examiner rejected Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over JP Pat. Application No. 1-139515 A in view of U.S. Patent No. 4,965,070 ('070).

The Examiner rejected Claims 1-3, 7, 11, and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over JP Pat. Application No. 8-239305 A in View of U.S. Patent No. 4,965,070 ('070).

The Examiner rejected Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,244,518 B1 in view of U.S. Patent No. 4,965,070 ('070).

Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. 112, second

paragraph, 101, 102(b), (e) and 103(a) with the following arguments.

35 U.S.C. 112, second paragraph and 35 U.S.C. 101

The Examiner rejected Claims 1-4 and 6-12 under 35 U.S.C. 101 and 112, second paragraph, as being allegedly indefinite because Claim 1 merely recites a use without any active, positive steps delimiting how this use is actually practiced. Accordingly, Applicant has amended Claim 1.

35 U.S.C. 102(b), (e)

The Examiner rejected Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(b) as being allegedly anticipated by JP Pat. Application No. 1-139515 A. Applicant respectfully traverses the Examiner's rejection because JP Pat. Application No. 1-139515 A does not teach each and every element of Applicants' claimed invention. Claim 1 states "[A] method, comprising: extracting a plant of an Alliaceae family, Allium genus; and **applying the extract to an exposed surface of a substrate** to repel animals, ..." (emphasis added). Japanese Pat. Appl. No. 1-139515-A teaches **a composition** that includes pepper, cayenne-pepper, Chinese pepper, mustard, Japanese horseradish, onion, garlic, ginger, turmeric, cinnamon, allspice and cardamom and the aromatic spice is e.g., clove, thyme, peppermint, perilla, sage, laurel, nutmeg, vanilla, fennel and coriander. Applicant respectfully submits that no where does Japanese Pat. Appl. No. 1-139515-A teach "**applying the extract to an exposed surface of a substrate**," as in Claim 1 (emphasis added).

In light of the foregoing, Applicant respectfully contends that Claims 1, 2, 4, 6, 8, 9, and

10 are in condition for allowance under 35 U.S.C. 102(b) over Japanese Pat. Appl. No. 1-139515-A, because Japanese Pat. Appl. No. 1-139515-A does not teach each and every feature of Claim 1.

The Examiner rejected Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(b) as being allegedly anticipated by JP Pat. Application No. 8-239305 A. Applicant respectfully traverses the Examiner's rejection of Claims 1, 2, 4, 6, 8, 9, and 10 over JP Pat. Application No. 8-239305 A because JP Pat. Application No. 8-239305 A does not teach each and every feature of Claim 1. Claim 1 states "[A] method, comprising: extracting a plant of an Alliaceae family, Allium genus; and applying the extract to an exposed surface of a substrate to repel animals, **wherein an animal feeding on the substrate is repelled...**" (emphasis added). Japanese Pat. Appl. No. 8-239305-A teaches a foamed material consisting of a sulfide compound or a material containing a sulfide compound, a repelling perfume and a synthetic polymer. It has high disposition flexibility and shape flexibility **and is effective for restricting the movement of** birds and animals such as cat, dog, rat and bird [from] scattering [their] feces in the living space of human and having daily actions harmful for human." See JP Pat. Application No. 8-239305 A, Abstract. Nowhere does JP Pat. Application No. 8-239305 A teach "**wherein an animal feeding on the substrate is repelled...**," as in Claim 1 (emphasis added). Instead, JP Pat. Application No. 8-239305 A teaches **restricting the movement of** birds ... etc." (emphasis added). See Id.

In light of the foregoing, Applicant respectfully contends that Claims 1, 2, 4, 6, 8, 9, and 10 are in condition for allowance under 35 U.S.C. 102(b) over JP Pat. Application No. 8-239305 A, because JP Pat. Application No. 8-239305 A does not teach each and every feature of Claim 1.

The Examiner rejected Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(e) as being allegedly anticipated by U.S. Patent No. 6,244,518 B1. Applicants respectfully traverse the Examiner's rejection of Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(e) using the same reasoning Applicant used to overcome the Examiner's rejection of Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 102(b) *supra*. Specifically, U.S. Patent No. 6,244,518 B1 does not teach **"applying the extract to an exposed surface of a substrate,"** or **"wherein an animal feeding on the substrate is repelled....,"** as in Claim 1 (emphasis added). USP 6,244,518 B1 teaches a "receptacle **into which** is placed a quantity of garlic or onion" (emphasis added). See USP 6,244,518 B1, Abstract. No where does USP 6,244,518 teach **"applying the extract to an exposed surface of a substrate,"** or **"wherein an animal feeding on the substrate is repelled....,"** as in Claim 1 (emphasis added).

In light of the foregoing, Applicant respectfully contends that Claims 1, 2, 4, 6, 8, 9, and 10 are in condition for allowance under 35 U.S.C. 102(e) over USP 6,244,518, because USP 6,244,518 does not teach each and every feature of Claim 1.

#### 35 U.S.C. 103(a)

The Examiner rejected Claims 1-4 and 6-12 under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 5,417,973 ('973) in view of U.S. Pat. No. 4,965,070 ('070). Applicant respectfully traverses the Examiner's rejection of Claims 1, 2, 4, 6, 8, 9, and 10 under 35 U.S.C. 103(a) because U.S. Patent No. 5,417,973 ('973) in view of U.S. Pat. No. 4,965,070 ('070) is an improper combination. Applicant respectfully submits that there is no motivation for one skilled in the art to look to '070 to modify U.S. Patent No. 5,417,973 ('973) because '973

teaches "repelling pests (e.g. insects and birds) from an animal **carcas**" (emphasis added). See '973, Abstract. In contrast, '070 teaches applying a repellent "**for warding off deer from a plant**" (emphasis added) . See '070, Abstract. Applicant respectfully contends that since '973 teaches "repelling pests (e.g. insects and birds) from an animal **carcass**" which is inherently not living, as is the "**plant**" in '070, there is no motivation for one skilled in the art to look to '070 to modify '973. Therefore, Applicant respectfully contends the combination of '973 and '070 is improper, and the rejection of Claim 1 under 35 U.S.C. 103(a) should be withdrawn.

In light of the foregoing discussion, Applicant respectfully contends that Claims 1-4 and 6-12 are patentable under 35 U.S.C. 103(a) over '973 in view of '070 because combination of '973 in view of '070 is improper because there is no motivation for one skilled in the art to look to '070 to modify '973.

The Examiner rejected Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over JP Pat. Application No. 1-139515 A in view of U.S. Patent No. 4,965,070 ('070). Applicant respectfully traverses the Examiner's rejection of Claims 1-3, 7, 11 and 12 because one skilled in the art would not be motivated to combine JP Pat. Application No. 1-139515 A in view of U.S. Patent No. 4,965,070 ('070) and therefore the combination is improper. JP Pat. Application No. 1-139515 A teaches a repellent so that when applied to garbage, "**the garbage is not rummaged or scratched by dogs, cats and birds**" (emphasis added). See JP Pat. Application No. 1-139515, Abstract and Use/advantage. Applicant respectfully asserts that one skilled in the art would not look to '070 to modify JP Pat. Application No. 1-139515 in order to use the combination of JP Pat. Application No. 1-139515 and '070 to establish a prima facie case of obviousness under 35 U.S.C. 103(a) because JP Pat.

Application No. 1-139515 teaches a repellent so that when applied to the garbage "**the garbage is not rummaged or scratched by dogs, cats and birds**" (emphasis added). In contrast, U.S. Pat. No. 4,965,070 ('070) teaches applying a repellent "**for warding off deer from a plant**" (emphasis added). See '070, Abstract. Preventing garbage from being **rumaged or scratched** as is taught in JP Pat. Application No. 1-139515 is not **warding off deer from a plant**, as is taught in '070. See '070, Abstract. Therefore, Applicant respectfully asserts the Examiner has failed to make a prima facie case of obviousness, required under 35 U.S.C. 103(a), because the combination of JP Pat. Application No. 1-139515 with '070 is improper because there is no motivation for one skilled in the art who knew the teaching of JP Pat. Application No. 1-139515 A 'to look to '070 **for warding off deer from a plant**, because JP Pat. Application No. 1-139515 A teaches a repellent so that when applied to the garbage "**the garbage is not rummaged or scratched by dogs, cats and birds**" (emphasis added). See JP Pat. Application No. 1-139515, Abstract and Use/advantage.

In light of the foregoing discussion, Applicant respectfully contends that Claims 1-3, 7, 11 and 12 are patentable under 35 U.S.C. 103(a) over JP Pat. Application No. 1-139515 A in view of U.S. Patent No. 4,965,070 ('070) because JP Pat. Application No. 1-139515 A in view of '070 is an improper combination, and the rejection of Claim 1 under 35 U.S.C. 103(a) should be withdrawn.

The Examiner rejected Claims 1-3, 7, 11, and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over JP Pat. Application No. 8-239305 A in view of U.S. Patent No. 4,965,070 ('070). Applicant respectfully traverses the Examiner's rejection of Claims 1-3, 7, 11, and 12 under 35 U.S.C. 103(a) over JP Pat. Application No. 8-239305 A in view of U.S. Patent

No. 4,965,070 ('070) because the combination is improper. JP Pat. Application No. 8-239305 A teaches a foamed material consisting of a sulfide compound or a material containing a sulfide compound, a repelling perfume and a synthetic polymer. It has high disposition flexibility and shape flexibility **and is effective for restricting the movement of birds and animals** such as cat, dog, rat and bird scattering feces in the living space of human and having daily actions harmful for human." See JP Pat. Application No. 8-239305 A, Abstract. U.S. Patent No. 4,965,070 ('070) teaches applying a repellant "**for warding off deer from a plant**" (emphasis added). See '070, Abstract. Applicant respectfully contends that the foamed material consisting of a sulfide compound or a material containing a sulfide compound, a repelling perfume and a synthetic polymer of JP Pat. Application No. 8-239305 A is not the plant of '070. Therefore, Applicant respectfully asserts the Examiner has failed to make a prima facie case of obviousness, required under 35 U.S.C. 103(a), because the combination of JP Pat. Application No. 8-239305 A with '070 is improper because there is no motivation for one skilled in the art who knew the teaching of JP Pat. Application No. 8-239305 A to look to '070 **for warding off deer from a plant**, because JP Pat. Application No. 8-239305 A teaches a foamed material consisting of a sulfide compound or a material containing a sulfide compound, a repelling perfume and a synthetic polymer. See JP Pat. Application No. 8-239305 A, Abstract.

In light of the foregoing discussion, Applicant respectfully contends that Claims 1-3, 7, 11 and 12 are patentable under 35 U.S.C. 103(a) over JP Pat. Application No. 8-239305 A in view of U.S. Patent No. 4,965,070 ('070) because JP Pat. Application No. 8-239305 A in view of '070 is an improper combination.

The Examiner rejected Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) as being

allegedly unpatentable over U.S. Patent No. 6,244,518 B1 in view of U.S. Patent No. 4,965,070 ('070). Applicant respectfully traverses the Examiner's rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,244,518 B1 in view of U.S. Patent No. 4,965,070 ('070) because the combination is improper. U.S. Patent No. 6,244,518 B1 teaches a "receptacle **into which** is placed a quantity of garlic or onion" (emphasis added). See U.S. Patent No. 6,244,518 B1, Abstract. U.S. Patent No. 4,965,070 ('070) teaches applying a repellant "**for warding off deer from a plant**" (emphasis added). See '070, Abstract. Applicant respectfully contends that the "receptacle **into which** is placed a quantity of garlic or onion" is not the **plant** of '070 (emphasis added). Therefore, Applicant respectfully asserts the Examiner has failed to make a prima facie case of obviousness, required under 35 U.S.C. 103(a), because the combination of U.S. Patent No. 6,244,518 B1 with '070 is improper because there is no motivation for one skilled in the art who knew the teaching of U.S. Patent No. 6,244,518 B1 to look to '070 **for warding off deer from a plant**, because U.S. Patent No. 6,244,518 B1 A teaches the "receptacle **into which** is placed a quantity of garlic or onion" is not the **plant** of '070 (emphasis added). See U.S. Patent No. 6,244,518 B1, Abstract.

In light of the foregoing discussion, Applicant respectfully contends that Claims 1-3, 7, 11 and 12 are patentable under 35 U.S.C. 103(a) over U.S. Patent No. 6,244,518 B1 in view of U.S. Patent No. 4,965,070 ('070) because U.S. Patent No. 6,244,518 B1 in view of '070 is an improper combination.

Applicant respectfully contends that Claims 1-4 and 6-12 are in condition for allowance under 35 U.S.C. 112, second paragraph, 101, 102(b), (e) and 103(a) because none of the prior art

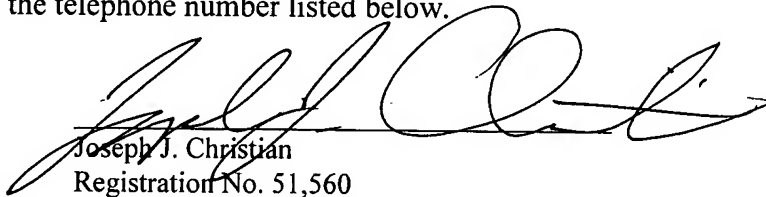


cited by the Examiner teaches or suggests each and every feature of independent Claim 1.

### CONCLUSION

In summary, based on the preceding arguments, Applicant respectfully submits that all independent claims and dependent claims meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below.

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## APPENDIX (MARKED-UP SPECIFICATION AND CLAIMS)

### In the Claims:

1. (AMENDED) A method, comprising:

extracting a plant of an Alliaceae family, Allium genus; and

applying the extract to an exposed surface of a substrate to repel animals, wherein an animal feeding on the substrate is repelled, and [wherein] further the substrate is selected from the group consisting of plants, living animals, manufactured objects and combinations thereof.